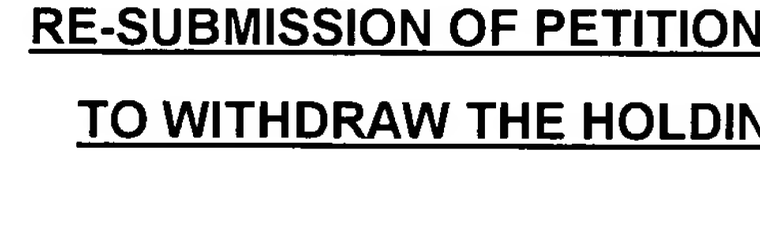
9200/1661
#17
11/4/03

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, Alexandria, VA, 22313; on

September 19, 2003
Date

Mark Bourgeois
Typed or Printed Name of Person Mailing Paper or Fee



9/16/2003
Signature Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:

Serial no.:	09/728,748
Filing date:	12/02/2000
For:	Veronica Plant named 'Glory'
Inventor:	Philpott
Atty. Docket no.:	PH17
Group Art Unit:	1661
Examiner:	Para

RE-SUBMISSION OF PETITION UNDER 37 C.F.R. §1.181

TO WITHDRAW THE HOLDING OF ABANDONMENT

A status check of the present application with Examiner Para on September 5, 2003 indicated that a petition to withdraw the holding of abandonment had not been entered into the patent office database.

Accordingly, the petition to withdraw the holding of abandonment originally submitted July 5, 2002 is being resubmitted.

The petitioner respectfully requests that the abandonment set forth in the notice mailed by the office on June 4, 2002 be withdrawn. In support of this petition the following documents are submitted:

1. A true copy of the petition to withdraw the holding of abandonment that shows a Certificate of Mailing of 7/05/2002.

2. A true copy of the return postcard for the petition with a USPTO date stamp of July 16, 2002.

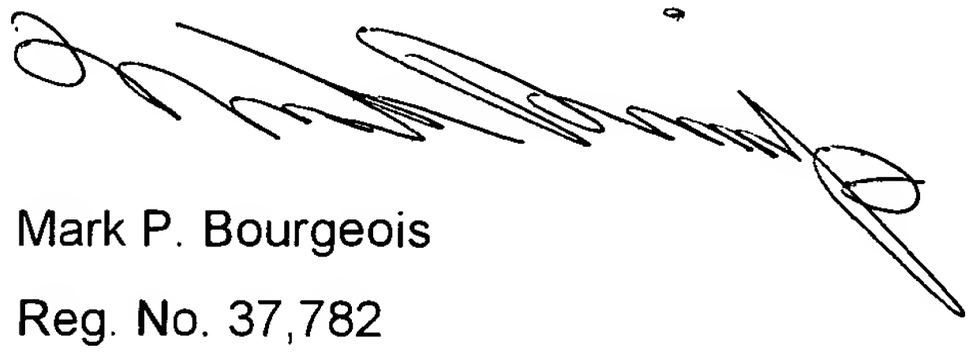
3. A true copy of the Notice of Abandonment for failure to respond mailed on 6/04/2002.

4. A true copy of the Applicant's Response to the first office action including a response to the request for information under 37 CFR 1.105 that shows a Certificate of Mailing executed on 11/26/2001.

It is believed that the response that was filed on November 26, 2001 was a *Bona Fide* response and that the application was improperly abandoned.

No fee is required for this petition. The applicant respectfully requests that the active status of this application be acknowledged and that the holding of abandonment be withdrawn.

Respectfully submitted,



Mark P. Bourgeois

Reg. No. 37,782

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C 20231; on

July 5, 2002
Date

Mark Bourgeois
Typed or Printed Name of Person Mailing Paper or Fee

7/05/2002
Signature Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:

Serial no.:	09/728,748
Filing date:	12/02/2000
For:	Veronica Plant named 'Glory'
Inventor:	Philpott
Atty. Docket no.:	PH17
Group Art Unit:	1661
Examiner:	Para

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

PETITION UNDER 37 C.F.R. §1.181

TO WITHDRAW THE HOLDING OF ABANDONMENT

Dear Sir:

This is in response to the Notice of Abandonment mailed 6/04/2002.

The petitioner respectfully requests that the abandonment set forth in the notice mailed by the office on 6/04/2002 be withdrawn. In support of this petition the following are submitted:

1. A true copy of the Notice of Abandonment for failure to respond mailed on 6/04/2002.
2. A true copy of the Applicant's Response to the first office action including a response to the request for information under 37 CFR 1.105 that shows a Certificate of Mailing executed on 11/26/2001.

It is believed that the response that was filed on November 26, 2001 was a *Bona Fide* response and that the application was improperly abandoned.

The variety that is the subject of this application has previously been protected by Plant Breeder's Rights certificates in one or more foreign countries. The referenced Plant Breeder's Rights Certificates were all applied for or granted more than one year prior to the filing date of this plant patent application in the United States. It is believed that it is improper to use 37 CFR 1.105 to request information from the Applicant regarding whether the variety was publicly available anywhere in the world prior to the filing date of the present application. The Examiner cites *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (BPAI 1992) as authority for this request for information.

With the Request under 37 CFR 1.105, the Examiner is attempting to set up an improper rejection under 35 USC 102(b). Under 37 C.F.R. 1.105(a)(1), the Examiner's authority to request information from the applicant is limited to "information as may be reasonably necessary to properly examine or treat the matter." In compliance with 37 C.F.R. 1.105(a)(1) and 37 C.F.R. 1.56, the Applicant submitted a response to the Request for Information under 37 CFR 1.105. The Response provides the Examiner with all information known to the Applicant regarding the public use and availability of the subject plant variety in the United States.

The Applicant did not however provide information regarding the public use and availability of the subject plant variety outside of the United States, as such information is not material to a determination of "plant patentability" of a plant variety in the United States.

The Examiner's intent in the present case is to refuse patentability of the new variety. Quoting from the office action, "If the plant was publicly available, then the application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant."

This examination strategy set forth by the Examiner results in a denial of plant patent protection in the United States based upon prior art which does not make the

plant variety available or accessible to the American public.

Applicant respectfully requests that the application be reinstated and that the scope of the Request for Information under 37 C.F.R. 1.105 be reconsidered.

Title 35 U.S.C. 102(b) reads, in pertinent part:

> A person shall be entitled to a patent unless
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

Protecting the public in its use of the invention when such use began prior to the filing of the application is clearly intended to refer to and to protect only the American public.

For example, if an invention has been in widespread public use in Brazil for the last 30 years, but is not the subject of any printed publication, then the original inventor has every right to file for and obtain patent protection in the United States. Section 102(b) expressly allows such a result. Because the foreign use of the invention is not deemed to have made the invention available to the American public. It is immaterial to any 102(b) policy analysis that the Brazilian public may have had the invention for the last 30 years.

How does the American public get access to a plant invention? In order for the American public to access and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be cloned, i.e., identically reproduced. See *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1566, citing *In re LeGrice*, 133 USPQ at 372 ("Asexual reproduction is the cornerstone of plant patent protection. The result of asexual reproduction is a plant that is genetically identical to its parent").

Many foreign plant varieties remain at present wholly unavailable to the American public, despite the existence of foreign printed publications, and despite public use of these varieties in foreign countries. Many of these varieties will offer valuable commercial advantages to the American public, once they become available

to the American public. The public policy underlying 102(b) is served by granting U.S. plant patents for those foreign plant varieties which have not been made available or accessible to the American public more than one year prior to the filing of the U.S. plant patent application.

Under 35 U.S.C. 102(b), an invention is not patentable if it was described in a printed publication, in this or a foreign country, more than a year prior to the filing date of the U.S. application. In order for a printed publication to serve as a reference under 35 U.S.C. 102(b), it must enable the invention. A written description of a plant variety is not enabling. Plant patents have always been exempt from the Section 112 written enablement requirement, which applies to all utility patents, in recognition that a particular plant cannot be reproduced by reference only to a printed publication alone. Congress acknowledged this concept when the Plant Patent Act of 1930 was drafted.

In order for a printed publication to be a 102(b) reference, it must be an enabling reference. A printed reference is enabling if a reader of the publication possessing ordinary skill in the art would be able to make and use the invention described without undue experimentation. Herein lies the distinction which sets plant patents apart from utility patents: A plant patent only confers protection on a specific plant which was invented (not any plant with the same characteristics), and its asexual progeny. See *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1566 (Fed. Cir. 1995). A written description of a plant variety may be capable of directing a breeder to independently create a new plant variety having the same observable characteristics as the described plant. However, the newly created plant would not infringe the specific patented plant, because it was not asexually produced from the germplasm of the specific plant. A printed publication which is available to the American public without corresponding availability of the actual plant material does not, and cannot, at the current level of technology, make the described plant available to the American public.

Because a plant patent cannot be infringed without direct access to the new plant or its asexual progeny, it is the applicant's position that a new plant variety cannot be anticipated without direct access by the American public in the United States to the new plant or its asexually reproduced progeny.

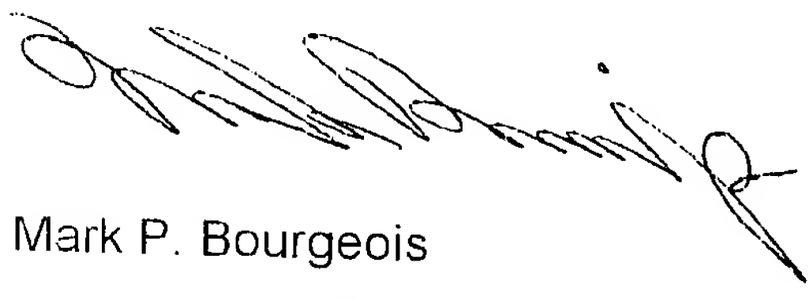
CONCLUSION

It has long been the practice of the U.S. Patent & Trademark Office to disregard the existence of foreign Plant Breeder's Rights certificates in determining patentability of a new plant variety. Additionally, the USTPO previously has not considered foreign publication, use, or sale of a new plant variety to be a bar to patentability in the United States.

It is believed that the response that was filed on November 26, 2001 was a *Bona Fide* response and that the application was improperly abandoned for failure to respond.

No fee is required for this petition. The applicant respectfully requests that the active status of this application be acknowledged and the holding of abandonment be withdrawn.

Respectfully submitted,



Mark P. Bourgeois

Reg. No. 37,782

The following papers were received today in the United States Patent and Trademark Office:

Docket number: PHI7
Serial number: 09/728,748
Applicant: Philpott
Title: Veronica Colby
Filing Date: 12/02/2000

- ☐ Specification, Claims # of pages ____
- ☐ Drawings: # of pages ____
- ☐ Declaration and Power of Attorney
- ☐ Assignment + Form PTO 1596
- ☐ Fee Enclosed: ____
- ☐ Information Disclosure Statement + Form PTO 1449
- ☐ Fee sheet
- ☐ Issue Fee Transmittal
- ☒ Amendment and response (copy)
- ☐ Substitute Specification # of pages ____
- ☐ Specification with Changes Marked # of pages ____
- ☒ Other Petition to withdraw ABANDONMENT
- ☒ Notice of Abandonment

Notice of Abandonment

Application No.	Applicant(s)	
09/728,748	PHILPOTT, HEATHER	
Examiner	**Art Unit**	
Annette H. Para	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on *13 September 2001*.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
   (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
   (c) ☒ A reply was received on *18 January 2002* but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☐ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☒ The reason(s) below:

Applicant did not disclose whether the plant had been publicly available outside the U.S. since this was a deliberate omission no extension of time is permitted. See MPEP 704.12(c)

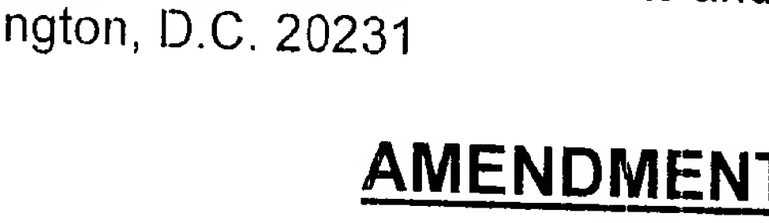
BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231; on

November 26, 2001
Date

Mark Bourgeois
Typed or Printed Name of Person Mailing Paper or Fee



11/24/2001
Signature Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:

Serial no.:	09/728,748
Filing date:	12/02/2000
For:	Veronica Plant named 'Glory'
Inventor:	Philpott
Atty. Docket no.:	PH-17
Group Art Unit:	1661
Examiner:	Para

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

AMENDMENT and RESPONSE

Dear Sir:

This is in response to the Office Action dated 09/13/2001. No additional fees are believed to be necessary.

Please amend as follows:

In the Claim:

Please delete the present claim and insert the new claim that is enclosed on the substitute specification.

In the Specification:

Please delete the present specification and insert the new specification that is enclosed on the substitute specification.

REMARKS

The following are applicant's response to issues raised in the Office Action dated 09/13/2001.

Specification Objections:

The specification was objected to because a less than complete description of the plant was presented. Accordingly, the specification has been amended along the lines of the examiner's suggestions to more clearly and completely describe the plant. Its is respectfully requested that the specification objections be withdrawn.

Rejection under 35 U.S.C. 112:

The claim was rejected under 35 USC 112 as not being supported by a clear botanical description. Accordingly, the botanical description has been amended to more clearly describe the plant. Its is respectfully requested that the 112 rejection be withdrawn.

The claimed plant is now believed to be in condition for allowance.

Request for information under 37 CFR 1.105:

In response to the request for information under 37 CFR 1.105, applicants submit the enclosed documents providing the following requested infcrmation:

A. Veronica 'Glory' CPVO Grant

B. Veronica 'Glory' CPVO Application

C. Veronica 'Glory' Proposed Denomination

Veronica Glory was first sold in the United States on October 4, 2000.

Applicants decline to provide information on sale or public availability outside of the United States.

35 U.S.C. 102:

It is noted that 102b states that only sale activities in the United States and not in other countries can trigger a 102b statutory bar.

Title 35 U.S.C. 102(b) reads, in pertinent part that a person shall be entitled to a patent unless the invention was in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. Veronica 'Glory' has not been in public use or sale in this country more than one year prior to the filing date of the present application.

The Applicant declines, however, to provide information regarding the public use and availability of the subject plant variety outside of the United States, as such information is not material to a determination of "plant patentability" of a plant variety in

the United States as defined by section 102b.

Applicant respectfully requests that the Examiner reconsider the scope of the Request for Information under 37 C.F.R. 1.105, and that the Examiner refrain from issuing any rejection under 102(b) based on any printed publication, either alone or in combination with foreign public use. It is believed that the Board of Appeals and Interferences and the Federal Circuit will not support any such rejections.

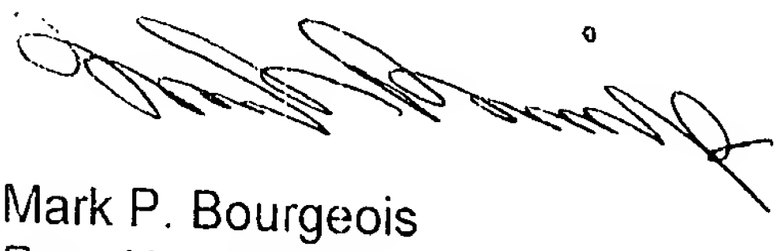
The response provides the Examiner with all information known to the Applicant regarding the public use and availability of the subject plant variety in the United States.

It is respectfully requested that the 102 rejection be withdrawn.

CONCLUSION:

The Examiner's attention to each of the parts of the patent application is greatly appreciated. A version of the substitute specification is attached showing the changes that were made.

Respectfully submitted,



Mark P. Bourgeois
Reg. No. 37,782